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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,248	12/18/2001	Kazuki Matsui	1405.1054	8732
21171 7590 12/24/2008 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER BEKERMANN, MICHAEL	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 12/24/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/020,248

Applicant(s)

MATSUI ET AL.

Examiner

MICHAEL BEKERMAN

Art Unit

3622

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-6 and 8-21 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-6, 8-17, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is responsive to papers filed on 8/21/2008.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 1, 4-6, 8-17, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein (U.S. Pub No. 2002/0107730) in view of Herz (U.S. Patent No. 5,754,938).**

Regarding claims 1, 10, 11, and 14-17, Bernstein teaches storing product information including product name and attribute for many different products (or product groups) (Paragraph 0017), accepting selection of a product from a merchant by a consumer (Paragraph 0025), assigning a correspondence between a consumer identifier and the product (transaction) (Paragraph 0023), and providing to the consumer a recommendation of a different product from a different merchant based on the first selected product (Paragraphs 0014, 0016, and 0023). Bernstein also teaches the system and method as being implemented at a physical vendor as well as through the Internet (Paragraph 0013). To link similar products to each other, product attributes must inherently be stored in the system. Bernstein teaches the system as comprising

any number of vendors and any number of customers (and thus, inherently more than 2 products) (Paragraph 0010). For a customer purchase history to be present, there must be a quantity purchased of at least 1 stored. The product(s) purchased represent product(s) in which a user has taken an interest, and these products are selected to determine a recommendation of other products. Both the first and second products are presented to the user on a receipt (Paragraph 0024).

Bernstein teaches the user's identity as being kept private from merchants on the system by using a customer information summary (Paragraph 0019) and a customer identifier (Paragraph 0023). Bernstein also teaches that buyers have a right to privacy (Paragraph 0005). Bernstein doesn't appear to specify the identifier as varying for each merchant. Herz teaches the ability of a user to vary his information per merchant (Abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to create a different identifier for each merchant in the interest of enhancing consumer privacy even further between specific merchants. Herz does not appear to specify the modification of an existing identifier to determine a new identifier for an alternate merchant. Herz teaches the old and well-known method of encryption for keeping certain information more secure (Figure 14, Reference 1401). Webster's dictionary defines the act of encrypting as "to put into code or cipher", which is simply a method of encoding, or modifying, information. While Herz does not specify using encryption to alter an identifier to create a new identifier, one of ordinary skill would have recognized that applying the known technique of encryption would have yielded predictable results and resulted in an improved (and more secure) system. For

any information to be presented over a computer system to any entity, that information must inherently be stored (whether it be short-term or long-term) in memory. This includes identifiers, product information and product attributes.

Regarding claim 4, Bernstein teaches authenticating the redeemed promotional materials (Paragraph 0022). Once this authentication takes place, the purchase will be added to the purchase history of the consumer and this reads on storing a correspondence between the user identifier and the second product.

Regarding claim 5, Bernstein teaches redemption of the promotional materials (Paragraph 0022). This inherently reads on a payment process.

Regarding claims 6 and 8, Bernstein teaches the system as comprising any number of vendors and any number of customers (and thus, inherently more than 2 products) (Paragraph 0010). Thus, the referral system of Bernstein would similarly continue as in claim 1 for a third merchant. Thus, these claims would be rejected under the same basis as that claim.

Regarding claim 9, Bernstein doesn't specify the ability for a merchant to update product information. Since Bernstein teaches the product information as being available on the system, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow merchants the ability to alter that information at a later date in case the product information changes.

Regarding claims 12, Bernstein teaches providing purchase history to a participating (second) vendor (Paragraph 0018).

Regarding claim 13, Bernstein teaches providing consumer information only in summary form (Paragraph 0019). This represents a disclosure level.

Regarding claim 20, Bernstein teaches storing product information including product name and attribute for many different products (or product groups) (Paragraph 0017), accepting selection of a product from a merchant by a consumer (Paragraph 0025), assigning a correspondence between a consumer identifier and the product (transaction) (Paragraph 0023), and providing to the consumer a recommendation of a different product from a different merchant based on the first selected product (Paragraphs 0014, 0016, and 0023). Bernstein also teaches the system and method as being implemented at a physical vendor as well as through the Internet (Paragraph 0013). To link similar products to each other, product attributes must inherently be stored in the system. Bernstein teaches the system as comprising any number of vendors and any number of customers (and thus, inherently more than 2 products) (Paragraph 0010). For a customer purchase history to be present, there must be a quantity purchased of at least 1 stored. The product(s) purchased represent product(s) in which a user has taken an interest, and these products are selected to determine a recommendation of other products. Both the first and second products are presented to the user on a receipt (Paragraph 0024).

Bernstein teaches the user's identity as being kept private from merchants on the system by using a customer information summary (Paragraph 0019) and a customer identifier (Paragraph 0023). Bernstein also teaches that buyers have a right to privacy (Paragraph 0005). Bernstein doesn't appear to specify the identifier as varying for each

merchant. Herz teaches the ability of a user to vary his information per merchant (Abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to create a different identifier for each merchant in the interest of enhancing consumer privacy even further between specific merchants. Herz does not appear to specify the modification of an existing identifier to determine a new identifier for an alternate merchant. Herz teaches the old and well-known method of encryption for keeping certain information more secure (Figure 14, Reference 1401). Webster's dictionary defines the act of encrypting as "to put into code or cipher", which is simply a method of encoding, or modifying, information. While Herz does not specify using encryption to alter an identifier to create a new identifier, one of ordinary skill would have recognized that applying the known technique of encryption would have yielded predictable results and resulted in an improved (and more secure) system. For any information to be presented over a computer system to any entity, that information must inherently be stored (whether it be short-term or long-term) in memory. This includes identifiers, product information and product attributes.

Bernstein teaches the system as comprising any number of vendors and any number of customers (and thus, inherently more than 2 products) (Paragraph 0010). Thus, the referral system of Bernstein would similarly continue as in claim 1 for a third merchant. Thus, this claim would be rejected under the same basis as that claim.

Regarding claim 21, neither Bernstein nor Herz appear to specify deleting an identifier should a recommended product not be selected after a given period of time. Official Notice is taken that it is old and well-known to delete an account of a user after a

fixed period of inactivity. Hotmail is an example of an website email service that deletes a user's email account if it goes unused over a specified period of time. It would have been obvious to one having ordinary skill in the art at the time the invention was made to delete an identifier for a user should that identifier go unused in the interest of keeping records more organized.

Response to Arguments

2. Applicant argues that the claimed limitations are to be performed prior to a purchase being made. However, Examiner has not found this limitation in the claim language. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

3. Applicant argues : "claim 1 does not recite requiring a purchase" and "Bernstein's disclosure does not teach selection, but rather requires a purchase". As explained in the rejection above, the claims merely recite selecting a product in which a user takes an interest, and a product that is purchased by a consumer is considered to be a product that the consumer has an interest in. While the claim does not *require* a purchase, the claim does not appear to require that a purchase not take place. Therefore, the purchase taught by Bernstein still meets the claim language.

4. Applicant argues "as claimed in claim 1, a second product is presented to the user prior to purchase based not upon a required purchase history, but merely upon the product attribute". As explained above, claim 1 does not recite a limitation such as

"prior to purchase" or "no purchase is to take place". Further, as explained in Paragraphs 0016, 0026, and 0027 of Bernstein, there are attributes of the products that are used in the determination of which products to promote. This meets the claim language regarding "product attribute".

5. Applicant argues "the user has control over the ability of third parties to access this summary and to identify or contact the user. In other words, Herz's users are not anonymous". This teaching of Herz does not mean that the identifier of Herz is not anonymous. This portion of Herz merely teaches that third parties are able to identify and contact the user using the identifier. This does not mean that the third party knows who the user is. Further, Examiner contends that this point is moot, since the identifiers used in Herz are not known to everyone (as they are varied for each party). Therefore, even if an identifier was known to one party, it would still be anonymous to another. Therefore, the identifiers of Herz are still "anonymous", which meets the claim language.

6. Applicant argues "[the language of claim 5] which inherently shows, based upon claim 5's dependency from claim 1, that a second product may be purchased without purchase of a first product". While this may be true, this language does not prevent a purchase of a first product from taking place. Therefore, while this may happen, it is not required to happen.

7. Any other arguments that may not have been addressed in this section are believed to be addressed by the amended claim language above (which has been underlined for Applicant's convenience).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MICHAEL BEKERMAN** whose telephone number is (571)272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. B./

Examiner, Art Unit 3622

/Eric W. Stamber/

Supervisory Patent Examiner, Art Unit 3622